

Amendment and Response

Applicant: David C. Lowery et al.

Serial No.: 10/677,120

Filed: October 1, 2003

Docket No.: 10354US01

Title: MAGNETIC RECORDING TAPE MEDIA HAVING LOW ABRASIVITY AND RELIABLE MEDIA PERFORMANCE

REMARKS

This is responsive to the Final Office Action mailed July 6, 2006. In that Office Action, the Examiner rejected claims 1-10 and 16-22 under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Mori et al., U.S. Patent No. 5,510,168 ("Mori").

With this Response, claims 23 and 24 have been added. Claims 1-10 and 16-24 are pending in the application and are presented for consideration and allowance.

35 U.S.C. §§102 & 103 Rejections

In response to the repeated rejection of independent claim 1 as being inherently anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Mori, Applicant respectfully submits that a *prima facie* case of inherency has not been established, such that the burden of proof remains with the Examiner. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); MPEP §2112 IV. Inherency may not be established by probabilities or possibilities. *In re Robertson*, 49 USPQ 1949, 1950-51 (Fed. Cir. 1999). With respect to the Examiner's reference to *In re Best*, it is noted that the burden shifts to the applicant when the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same. *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). With these standards in mind, it is respectfully submitted that the mere possibility that the media construction of Mori might provide the claimed Abrasivity Index is insufficient. As evidenced by the pending specification, while magnetic recording media is known, prior to the present invention, magnetic recording media having an Abrasivity Index of less than 350 microinches was not. Because Mori makes passing reference, at best, to an abrasive material additive, a sound basis for believing that the media of Mori and the products of the Applicant are the same does not exist. Because Mori does not inherently teach or suggest at least the Abrasivity Index limitation of claim 1, it is respectfully requested that the rejection of claim 1 be withdrawn.

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Claims 2-10 and 16-21 depend from claim 1 and thus, for at least the above reasons, are allowable. In addition, it is respectfully noted that Office Action fails to identify teachings of Mori commensurate with the limitations of at least claims 17, 18, and 20. In fact, Mori does not disclose any of the limitations of at least these dependent claims, such that Mori clearly does not inherently anticipate any of claims 17, 18 or 20. Examination of these claims is respectfully requested.

Newly presented claim 23 depends from claim 1, and thus for at least the reasons above, is allowable. In addition, claim 23 recites that the magnetic recording medium exhibits a recording density of 55 kfc. Support for this language is found, for example, at page 3, lines 14-15 and page 5, lines 1-2. In contrast, nothing in Mori describes a corresponding recording density characteristic, such that claim 23 recites additionally allowable subject matter.

Newly present claim 24 recites a magnetic recording medium including a substrate and a magnetic coating formed thereon. The magnetic coating exhibits an Abrasivity Index in the range of 150-300 microinches, and includes a conductive carbon black material having an average particle size of less than 20 nm. Support for this language is found, for example, at page 7, lines 15-17. For the reasons described above with respect to claim 1, it is respectfully submitted that the Abrasivity Index limitation of claim 24 defines allowable subject matter over Mori. In addition, Mori does not disclose a conductive carbon black material, let alone conductive carbon black with an average particle size of less than 20 nm. At best, Mori describes carbon black having an axial length on the order of 300 nm. *Mori*, col. 5, ll. 62-63 and col. 6, ll. 13-15. Thus, Mori cannot be viewed as inherently teaching or suggesting the limitations of claim 24 in that an identical structure is not provided, such that claim 24 is allowable over Mori.

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CONCLUSION

In view of the above, Applicants respectfully submit that pending claims 1-10 and 16-24 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-10 and 16-24 are respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 09-0069.

The Examiner is invited to contact the Applicants' representative at the below-listed telephone number to facilitate prosecution of this application. Any inquiry regarding this Amendment and Response should be directed to either Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005 or Eric D. Levinson at Telephone No. (651) 704-3604, Facsimile No. (651) 704-5951.

In addition, all correspondence should continue to be directed to the following address:

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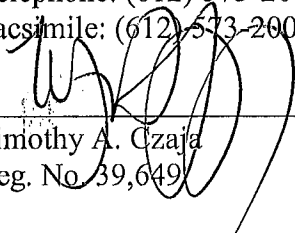
Respectfully submitted,

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